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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,168	12/28/2001	Lene Teuber	2815-0187P	4595

2292 7590 02/21/2003

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EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
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1624

8

DATE MAILED: 02/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
10/029,168

Applicant(s)
Teuber et al.

Examiner
Bruck Kifle, Ph.D.

Art Unit
1624



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Dec 11, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above, claim(s) 2-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

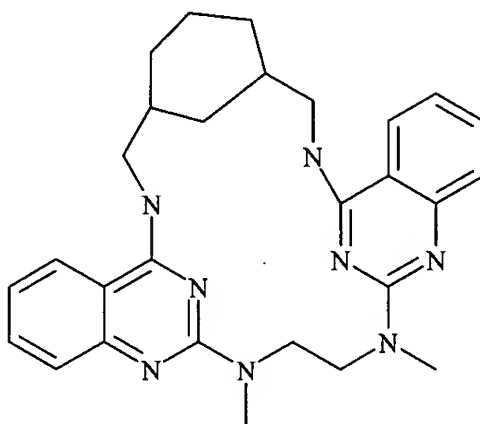
Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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Election/Restriction

Applicant's election with traverse of the species of claim 6 in Paper No. 7 is acknowledged. Applicants provided the following structural formula of the elected species:



(Note, the nitrogens at positions 2 and 10 fail to meet the valence requirement). The traversal is on the grounds that the statutory standard has not been met; applicant has the right to define his invention; there is no serious burden; applicant has paid for an examination of all claims and that discretion should be exercised. This is not found persuasive because restriction/election is proper when two or more independent and distinct inventions may not be claimed in one national application; there is no rejection made under 35 USC 112 and one invention belongs in one patent. Applicants have paid for the examination of one invention.

Should applicants traverse on the ground that the groups are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing these groups to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the groups unpatentable over the prior art, the evidence or admission may

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and will be used in a rejection under 35 U.S.C. 103(a) of the other invention. Applicants, however, have not so stated.

A compound of formula I, as claimed in claim 1, wherein A and B are methylene groups and R¹ and R² together and R³ and R⁴ together do not form a ring is patentably distinct from a compound, say, wherein A and B are oxy and R¹ and R² together and R³ and R⁴ together form a heterocyclic ring.

Finally, the examiner will use his discretion to expand the search and examination of the claims.

The requirement is still deemed proper and is therefore made FINAL.

Abstract

This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

Applicant is reminded of the proper content of an Abstract of the Disclosure.

In chemical patent abstracts for compounds or compositions, the general nature of the compound or composition should be given as well as its use, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

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The elected compound was not found in the search and the search was expanded.

Claims 2-18 are withdrawn from consideration because art was found (see MPEP 803.02.).

Applicants are also advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth paragraph, where is stated;

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**” (emphasis added).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Mikhailov et al. (Doklady Akademii Nauk (1998), 362(5), 643-644). The claim reads on the compounds of RN 250355-09-0 and 250355-10-3 (see CAS abstract and structure kindly provided by Applicants).

Claim Rejections - 35 USC § 112

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- i) The preamble of claim 1 reads "A 2,4-bridged bis-4-amino-pyrimidine derivative represented by the general Formula I". It is suggested to rewrite this as "A compound of formula" if the compound is being claimed. The way the claim is written one cannot say which derivative is intended and what else is being claimed by the term "general." Also, not everyone names the compound 2,4-bridged bis-4-amino-pyrimidine. Even the elected compound is not named 2,4-bridged bis-4-amino-pyrimidine.
- ii) In the definition of A and B, it is unclear which atoms or groups are intended. It is only stated that "a linking group having a chain length comprising 1 to 20 separate bonds" is intended. When only 1 bond is present, there cannot be any group present. Also, the elected compound has ring bonds within A. A clarification is required.
- iii) The term "carbocyclic" is indefinite because it is not known how many atoms make up the ring. In polycyclic carbocyclic it is unclear what kind of a ring is intended (spiro, fused, bridged, saturated, etc.).


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- iv) Similarly, the term "heterocyclic" is indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended.
- v) The "hetero-alkyl" group is also indefinite because one cannot say what the point of attachment is, where the heteroatom is located and what this heteroatom is.
- vi) The group "amido" is indefinite (see page 26, line 27 and page 27, line 9). One cannot say where this group is attached and what else is present. Should Applicants intend -C(O)-NH_2 , then the term carboxamido is suggested.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle whose telephone number is (703) 305-4484.

The fax phone number for this Group is (703) 308-4556 or (703) 305-3592. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

February 20, 2003


Bruck Kifle
Primary Examiner
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